

### REMARKS

Claims 13, 18 and 20 are canceled without prejudice, and therefore claims 11, 12, 14 to 17 and 19 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

With respect to paragraph one (1) of the Office Action, to facilitate matters, enclosed are courtesy copies of the foreign references referred to in the prior IDS and 1449. It is respectfully requested that the Examiner consider all such references, and acknowledge their consideration, consistent with U.S.P.T.O. practice and the MPEP. Updated Supplemental IDS and PTO-1449 papers reflect the fact that the foreign references have been provided (although they should have been provided by the International Searching Authority). No fees are believed to be due, since these references were originally disclosed by the earlier filed IDS and PTO-1449.

Applicants thank the Examiner for indicating that claims 13 to 15, 19 and 20 contain allowable subject matter, since these claims were only objected to in the Office Action. While the objections may not be agreed with, to facilitate matters, claim 11 has been rewritten to include the features of claim 13, which has been canceled without prejudice. Claim 2 depends from allowable claim 11 and is therefore allowable. Claims 14 and 15 now include the features of claim 11, and are therefore allowable. While the objections may not be agreed with, to facilitate matters, claim 16 has been rewritten to include the features of claim 20, which has been canceled without prejudice. Claim 19 now include the features of claims 16 and 18 (claim 18 has been canceled without prejudice), and is therefore allowable, as is claim 17, which now depends from claim 19.

Accordingly, claims 11, 12, 14 to 17 and 19, as presented, are allowable. It is therefore respectfully requested that the objections be withdrawn as to claims 13 to 15, 19 and 20.

Claims 11, 12, and 16 to 18 were rejected under 35 U.S.C. § 102(b) as anticipated by Polzin, DE 100 53 608 (which assertedly corresponds to U.S. Pat. No. 6,681,168).

As regards the anticipation rejections, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is

respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As explained above, while the objections may not be agreed with, to facilitate matters, claim 11 has been rewritten to include the features of claim 13, which has been canceled without prejudice. Claim 2 depends from allowable claim 11 and is therefore allowable. Claims 14 and 15 now include the features of claim 11, and are therefore allowable. While the objections may not be agreed with, to facilitate matters, claim 16 has been rewritten to include the features of claim 20, which has been canceled without prejudice. Claim 19 now include the features of claims 16 and 18 (claim 18 has been canceled without prejudice), and is therefore allowable, as is claim 17, which now depends from claim 19.

It is therefore respectfully requested that the anticipation rejections as applied be withdrawn.

Accordingly, claims 11, 12, 14 to 17 and 19, as presented, are allowable.

**Conclusion**

It is therefore respectfully submitted that all of claims 11, 12, 14 to 17 and 19 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

Dated: \_\_\_\_\_

1/16/2008

By: \_\_\_\_\_

Gerard A. Messina  
Reg. No. 35,952

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200

**CUSTOMER NO. 26646**

*By [Signature]*  
*Reg. No. 33,865*  
*Haven C. OEDITION*